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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,818	06/30/2003	Jari Karjala	004770.00134	7985
22907 7590 07/05/2007 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER OKORONKWO, CHINWENDU C	
			ART UNIT 2136	PAPER NUMBER
			MAIL DATE 07/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/608,818	Applicant(s) KARJALA ET AL.	
	Examiner Chinwendu C. Okoronkwo	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/10/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20070427</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. For the record, the Examiner acknowledges that no priority claim has been made in regards to this application.

Information Disclosure Statement

2. For the record, the Examiner acknowledges that the IDS submitted on 04/27/2002 has been received and considered.

Oath/Declaration

3. For the record, the Examiner acknowledges that the Oath/Declaration submitted on 10/14/2003 has been received and considered.

Drawings

4. For the record, the Examiner acknowledges that the Drawings submitted on 06/30/2003 have been received and considered.

Specification

5. For the record, the Examiner acknowledges that the Specification submitted on 06/30/2003 has been received and considered.

Response to Arguments

6. In response to communications filed on 04/10/2007, applicant amends claims 1 and 12. The following claims, claims 1-14, are presented for examination.

6.1 Applicant's arguments with respect to claim 1 – 14 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No. **10/609011**. Although the conflicting claims are not identical, they are not patentably distinct from each other because both create secure communication links using certificates and key pair.

Claims 1-48 of copending Application No. **10/609011** contain every element of claims 1-14 of the instant application and thus anticipate the claims of the instant application. Claims 1-14 of the instant application therefore are not patently distinct from the copending application claims and as such are unpatentable for obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species with that genus). "ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

"Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is "anticipated" by the species of the patented invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic claim. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting." (In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa et al. (European Patent No. 1475721 A1) further in view of Coates et al. (US 2001/0047400 A1).

Claims 1-14 are rejected under 35 U.S.C. 102(e) as being disclosed by.

Regarding claim 1, Ogawa et al., discloses a method for conducting secure communications, comprising: (a) connecting a user device via a publicly-accessible network to a server; (b) receiving a certificate; (c) calculating an identifier of the received certificate and converting it to a character string; (d) modifying the string by removing at least one random character from the string; (e) displaying the modified string; (f) receiving, from a user previously provided with the identifier through a trusted medium, input corresponding to the at least

one removed character; and (g) continuing connection to the server only if the user input matches the at least one removed character (0024-0034).

Ogawa et al. does not explicitly disclose the matching of the certificate and maintaining connection as claimed.

Coates et al. however teaches the calculating the fingerprint for the certificate and comparing it with the key with the user's system for establishing/maintaining connection (paragraph 83 - 85).

It would have been obvious to one of ordinary skill in the art of data processing at the time of the present invention to combine the teachings of cited references because they are both directed in the same field of establishing secure network connections between server and users. Furthermore, the calculation of the fingerprint of the certificate and then comparing it with the key obtained by user would enhance the secure connections within trusted networks and users (paragraphs 77 and 83 – 87, Coates et al.)

Claims 2 – 11 are rejected under the same rationale as claim 1. For references for further limitations please see the citations below.

Regarding claim 2, Ogawa et al., discloses the method of claim 1, further

comprising randomly selecting multiple characters for removal (0035-0036).

Regarding claim 3, Ogawa et al., discloses the method of claim 2, wherein the randomly selected characters are replaced with a character indicating the replacement (0024-0036).

Regarding claim 4, Ogawa et al., discloses the method of claim 2, wherein the modified string is displayed with spaces replacing the removed characters (0039-0041).

Regarding claim 5, Ogawa et al., discloses the method of claim 1, wherein the device is a mobile telephone and the at least one removed character is a digit (0026, 0035-0036 and 0047).

Regarding claim 6, Ogawa et al., discloses the method of claim 1, wherein receiving the certificate comprises receiving the certificate from a certification authority (0024-0034).

Regarding claim 7, Ogawa et al., discloses the method of claim 1, wherein the position of the at least one character removed from the string is different during a subsequent connection attempt (0035-0036).

Regarding claim 8, Ogawa et al., discloses the method of claim 1, wherein the at least one removed character is removed based on the capabilities of the user device (0035-0036).

Regarding claim 9, Ogawa et al., discloses the method of claim 1, wherein receiving input corresponding to the at least one removed character comprises receiving input from a user previously provided with the identifier through a one of the mail or a company newsletter (0041-0043).

Regarding claim 10, Ogawa et al., discloses the method of claim 1, wherein the at least one removed character is a digit, and wherein no non-digit characters are removed (0035-0036).

Regarding claim 11, Ogawa et al., discloses the method of claim 1, further comprising: repeating steps (a) through (g) on each attempt to connect the device to the server (Rejected under the same rationale as claim 1).

Regarding claim 12, Ogawa et al., discloses the device for secure communication with a server via a publicly accessible network, comprising: an interface to a publicly accessible network; and a processor configured to perform steps comprising: receiving, via the interface, a certificate from a remotely located server, calculating an identifier of the received certificate and converting

it to a character string, modifying the string by removing at least one random character from the string, displaying the modified string, receiving, from a user of the device previously provided with the identifier through a trusted medium, input corresponding to the at least one removed character, and continuing connection to the server only if the user input matches the at least one removed character (Rejected under the same rationale as claim 1).

Regarding claim 13, Ogawa et al., discloses the machine-readable medium having machine-executable instructions for performing steps comprising: (a) connecting a user device via a publicly-accessible network to a server; (b) receiving a certificate; (c) calculating an identifier of the received certificate and converting it to a character string; (d) modifying the string by removing at least one random character from the string; (e) displaying the modified string; (f) receiving, from a user previously provided with the identifier through a trusted medium, input corresponding to the at least one removed character; and (g) continuing connection to the server only if the user input matches the at least one removed character (Rejected under the same rationale as claim 1).

Regarding claim 14, Ogawa et al., discloses the method for conducting secure communications, comprising: (a) connecting a user device via a publicly-accessible network to a server; (b) receiving a certificate; (c) receiving a modified identifier, the identifier having previously been calculated for the certificate

outside of the user device and modified outside of the user device by removal of at least one random character; (e) displaying the modified identifier; (f) receiving, from a user previously provided with the identifier through a trusted medium, input corresponding to the at least one removed character; and (g) continuing connection to the server only if the user input matches the at least one removed character (Rejected under the same rationale as claim 1).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chinwendu C. Okoronkwo whose telephone number is (571) 272 2662. The examiner can normally be reached on MWF 9:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on (571) 272 4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

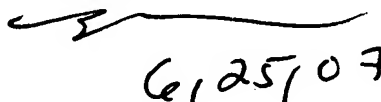
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CCO

June 25, 2007

NASSER MOAZZAMI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100



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